

### **REMARKS**

The Official Action mailed November 4, 2003, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for Two Month Extension of Time*, which extends the shortened statutory period for response to April 4, 2004. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on November 19, 2001; March 12, 2002; April 28, 2003 (received by OIPE on April 30, 2003); and May 29, 2003. However, as noted in detail below, the Applicant has not received an indication of the full consideration of the IDS's filed December 23, 2002, March 3, 2003, and April 28, 2003 (received by OIPE on May 2, 2003).

With respect to the IDS filed December 23, 2002, the Examiner asserts that "Regarding the complaint/answer, these are not prior art and thus are not considered" (page 2, Paper No. 13). As noted in MPEP § 2001.06(c), the Applicants are under a duty of disclosure which includes information from related litigation. The Applicants respectfully submit that the IDS filed December 23, 2002, fully complies with 37 CFR 1.98 and should be considered by the Examiner. It is noted that the Examiner has considered other IDS's which include information from related litigation, e.g. the IDS filed May 29, 2003.

The Applicant notes the partial consideration of the IDS filed on March 3, 2003. Specifically, it appears that the Examiner inadvertently overlooked the citation of *Preliminary Invalidity Contentions of Acer Incorporated, Acer America Corporation, and AU Optronics Corporation*. As noted above, an IDS including information from related litigation should be considered by the Examiner.

The Applicant has not received acknowledgment of the IDS filed on April 28, 2003 (received by OIPE on May 2, 2003), which cites JP 63-316885 and FR 2549627. The Applicant respectfully requests that the Examiner provide an initialed copy of the

Form PTO-1449 evidencing consideration of the IDS's filed December 23, 2002, March 3, 2003, and April 28, 2003 (received by OIPE on May 2, 2003).

Claims 35 and 38-60 are pending in the present application, of which claims 35, 38-42, 54 and 55 are independent. Claims 41, 42, 54 and 55 have been amended in response to an indefiniteness rejection. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 41, 42, 47 and 52-60 under 35 U.S.C. § 112, second paragraph, asserting that the "limitation wherein the diameter decreases by at least 35 percent is indefinite" (page 2, Paper No. 19). In response, the Applicant has amended claims 41, 42, 54 and 55 to recite "wherein a thickness of the conductive particle decreases at least 35% after applying a pressure." The Applicant respectfully submits that independent claims 41, 42, 54 and 55 and their dependent claims are definite as amended. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 35, 38-42, 54 and 55 as obvious based on the combination of U.S. Patent No. 5,089,750 to Hatada et al. and U.S. Patent No. 4,740,657 to Tsukagoshi et al. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. All of the independent claims 35, 38-42, 54 and 55 recite that one of the first end and the second end of the first electrode is inside of an edge of the substrate. Hatada and Tsukagoshi, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention. It appears that the Official Action is relying on electrode 14 of Hatada for the first electrode of the present invention, conductive pattern 24 of Hatada for the second electrode of the present invention, and resin 28 for the conductive adhesive of the adhesive of the present invention (page 2, Paper No. 19). As such, when viewing Figure 1 of Hatada for example, the right end of electrode 14 would appear to be the one of the first end and the second end of the first electrode to be covered by the resin 28. However, the right end of electrode 14 is not inside of an edge of the substrate as required by the independent claims of the present invention. Tsukagoshi does not cure this deficiency in Hatada. Tsukagoshi is relied upon to teach features which are unrelated to the position of the edge of the first electrode which is covered by the conductive adhesive with respect to the edge of the substrate. Therefore, Hatada and Tsukagoshi, either alone or in combination, do not teach or suggest that one of the first end and the second end of the first electrode (the end covered by the conductive adhesive) is inside of an edge of the substrate.


Also, independent claims 39, 40, 54 and 55 recite providing at least one second electrode, where the second electrode is coated with Ni and Au. Hatada and

Tsukagoshi, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention. The Official Action states that regarding "the coating of Au or Ni, see column 6 [of Tsukagoshi]" (page 3, *Id.*). The Applicant respectfully submits that Tsukagoshi does not teach or suggest providing at least one second electrode, where the second electrode is coated with Ni and Au. Rather, Tsukagoshi appears to disclose electroconductive particles comprising polymeric core materials 1 coated with thin metal layers 2 (Figure 1, abstract), and that the thin metal layers 2 may be made of materials such as Zn, Al, Sb, U, Cd, Ga, Ca, Au, Ag, Co, Sn, Se, Fe, Cu, Th, Pb, Ni, Pd, Be, Mg, and Mn (column 6). The polymeric core material 1 of Tsukagoshi is not at all related to an electrode, as defined by the claims of the present invention. Therefore, Tsukagoshi does not teach or suggest coating an electrode with Ni and Au.

Since Hatada and Tsukagoshi do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
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